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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,844	01/27/2000	Joel Ronning	D33-029-03-US	1448
54092	7590	10/03/2006	EXAMINER	
NORTH OAKS PATENT AGENCY 45 ISLAND ROAD NORTH OAKS, MN 55127				GARG, YOGESH C
ART UNIT		PAPER NUMBER		
		3625		

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/492,844	RONNING ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Yogesh C. Garg	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 December 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3,8,14-16,23,25,30,36-38,67 and 68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1, 3, 8, 14-16, 23, 25, 30, 36-38, 67, and 68 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____.                                     |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____.                         |

## DETAILED ACTION

### ***Response to Amendment***

1. Request for reconsideration received on 12/29//2005 is acknowledged and entered. None of the claims is amended. Currently claims 1, 3, 8, 14-16, 23, 25, 30, 36-38, 67, and 68 are pending for examination.

### ***Response to Arguments***

2.1. Objection to **Priority claim:** The applicant's arguments, see Remarks, pages 6-8, and the interview summary mailed on 9/28/2006, have been fully considered and found persuasive and therefore, the Objection to the Priority claim presented in the earlier Office action mailed on 6/29/2005, is withdrawn.

2.2 Applicant's arguments filed on 12/29/2005, see Remarks on pages 8-11, concerning rejection of claims 1, 3, 8, 14-16, 23, 25, 30, 36-38 and 67-68 under 35 USC 103 (a) as being unpatentable over Downs in view of Rogers (US Patent 5,652,786) have been fully considered but not found persuasive for following reasons:

The applicant argues, see page 9, lines 1-15, that the cite reference Rogers is a nonanalogous art. The examiner respectfully disagrees. In response to applicant's argument that Rogers is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied

upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the applicant faces the problem that if a illegitimate user tries to access the server using a file identifier to conduct a commercial online transaction, such as downloading content by using several attempts to verify himself then how to automatically prevent the downloading action after a permitted number of attempts. In the analogous art, Rogers faced the same problem of stopping fraudulent activities such as, accessing an account online by making illegitimate unlimited fishing attempts to access the account and arrived at a solution of stopping the user's online activity if he is not able to input and verify the correct identifier, that is the access code within three attempted trials. Roger's solution is similar to the solution the applicant provides in his invention and independent claims, that is allowing a number of attempts, such as three in Rogers, for verify the file/order identifiers to enable the commercial transaction of downloading a file.

The applicant argues that Rogers's reference is non-enabling because it does not teach downloading of anything. The examiner respectfully disagrees because the applicant is attacking the Roger's reference individually when the rejection is made under 35 USC 103 (a) in view of the combined teachings of Downs and Rogers. Downloading of files is taught by Downs'618, but Downs did not teach the limitation of allowing the online commercial transaction of downloading based upon a number of permitted attempts in verifying the file/order identifier Roger's analogous teachings of limiting the access to an online account for conducting an online transaction based upon a maximum of three attempts to provide the right access code. The concept of limiting

the access to an online account for conducting an online transaction based upon a number attempts to provide a verifiable identifier [which is a valid access code in Rogers or valid file and order identifiers in the claimed application] can be used in any online transaction, irrespective of the nature of online transaction, that is bill payment in Rogers or downloading content in the claimed application. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The applicant further argues (see Remarks, pages 10-11), that there is no suggestion to combine the arts of Downs and Rogers and hence Examiner has failed to establish a *prima facie* case of obviousness. The examiner respectfully disagrees. In response to applicant's argument that there is no suggestion or motivation to combine the teachings of Downs and Rogers, the test for obviousness is not whether the features of a secondary reference, that is the teachings of Rogers may be bodily incorporated into the structure of the primary [Downs] reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In the present case, it would be obvious to one of an ordinary skilled in the art that when the teachings of downloading a content, in Downs, are combined with the Roger's teachings of limiting the access to an online account for

conducting an online transaction based upon a number attempts to provide a valid access code would result in permitting the downloading of content based upon a limited number of the user's attempts to enter the correct verifiable identifier. Doing so would help to stop the online transaction of downloading, which is expected to follow after providing the correct access code/identifiers, to avoid possible fraudulent activity by illegitimate persons who are on a fishing expedition to access online accounts.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the present case, it would be obvious to one of an ordinary skilled in the art that when the teachings of downloading a content, in Downs, are combined with the Roger's teachings of limiting the access to an online account for conducting an online transaction based upon a number attempts to provide a valid access code would result in permitting the downloading of content based upon a limited number of the user's attempts to enter the correct verifiable identifier. Doing so would help to stop the online transaction of downloading, which is expected to follow after providing the correct access code/identifiers, to avoid possible fraudulent activity by illegitimate persons who are on a fishing expedition to access online accounts. The examiner has taken into

account only knowledge from the prior arts of Downs and Rogers and within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would be obvious to one of an ordinary skilled in the art that when the teachings of downloading a content, in Downs, are combined with the Roger's teachings of limiting the access to an online account for conducting an online transaction based upon a number attempts to provide a valid access code would result in permitting the downloading of content based upon a limited number of the user's attempts to enter the correct verifiable identifier. Doing so would help to stop the online transaction of downloading, which is expected to follow after providing the correct access code/identifiers, to avoid possible fraudulent activity by illegitimate persons who are on a fishing expedition to access online accounts.

In view of the foregoing, the rejection of claims 1, 3, 8, 14-16, 23, 25, 30, 36-38 and 67-68 rejected under 35 U.S.C. 103(a) as being unpatentable over Downs and

Rogers is sustainable as presented in the earlier Office action mailed on 6/29/2005 and is reproduced again below. This is a Final rejection..

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

**(a)** A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.1. Claims 1, 3, 8, 14-16, 23, 25, 30, 36-38 and 67-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs and further in view of Rogers (US Patent 5,652,786), hereinafter, referred to Rogers.

**Regarding claims 1, 3, 8, 16, and 67,** Downs teaches a method performed by an electronic commerce system having a server and an end user machine interacting through a network for secure downloading of a file from the network, the method comprising steps of:

receiving a selection of a file via the network, receiving an order from a user, during an online session, for download of the selected file, the order including a file identifier related to the file and an order identifier related to the order, verifying the file identifier based upon particular information related to the file comprising one or more of the following: verifying a version identifier related to the file, a uniform resource locator for the file; or verifying the order identifier based upon particular information related to

the order comprising a custom identifier associated with the user, verifying a transaction identifier associated with the order, and the particular information related to the order including : determining if the order identifier is valid for the order, meaning the order identifier exists for the order, determining if the order identifier is active, meaning the order was not canceled before the download of the file, and determining if the order identifier is non-suppressed, meaning the order was not canceled after the download of the file, during the online session, and selectively permitting the download of the file based upon a number of requested downloads based upon the verification of the file identifier, transaction identifier and the order identifier, receiving a selection of a uniform resource locator for the file and determining if the uniform resource locator is valid, active, non-suppressed or charged, also selectively downloading the file based upon a number of successful downloads of the file and upon a time parameter related to submission of the order, and denying the download based upon a customer identifier associated with the user (at least see, col.3, lines 40-55, ....*transferring the encrypted data....clearing house....transferring the re-encrypted data.....to the user's system....*”). col.7, lines 2-16, “..*licensing authorization and control....conditions of purchase and license, such as permitted number of copies, number of plays, and the time interval or term the license may be valid .....*enabling intermediate or End-User (s) to unlock content after verification of a successful completion of licensing transaction..”, col.8, lines 26-31, “..*The architecture is open...Distribution of audio, programs, multimedia, video or other types of Content....*”, col.10, lines 19-26, “...*Once an Electronic Digital Content Store(s) 103 completes a valid request for Electronic Content 113 from an End-*

User(s).....*The Electronic Digital Content Stores (s) also authorizes the download of the SC containing the Content 113* “, col.11, lines 30-54, “..*The End-User Device(s) 109 can be any player device.....The End-User device (s) 109 manages the download and storage of SCs containing the Digital Content.....the use or running-on an End-User device(s)* “, col.24, lines 17-47, “...*Upon reception of the Order SC9s) 650 from the Ned-User Devices (09), the Clearinghouse (s) 105 verifies: .....2. that the order SC (s) 650 has not been altered.....Transaction Data 642 and Symmetric Key 623 are complete and authentic.....If the verifications are successful.....transfers the License SC (s) 660 to the End-User Device (s) 109....”, col.26,lines 24-58, “...*When an End-User Devices (109 receives the Content.....Instead, the SC (s) includes an external URL.....to point to the Content 113.....Electronic Digital Content Store (s) 103 also.....extracting metadata information from them to build HTML pages.....present descriptions of Content 113 to End-User (s), usually so they can purchase the Content 113* “, col.27, lines 6-21, “..*The End-User device (s) 109 receives the Transaction SC (s) 640 and validates the integrity of the Transaction SC (s) 640 and the included Offer SC (s) 641.....The Clearinghouse (s) 105 validates and processes Order Sc (s) 650...access purchase Content 113* “, col.28, lines 30-50, “...*Each record includes .....a URL that points to another SC (s) that includes the encrypted part...*”, col.29 line 18- col.30, line 62, “...[Content URL]....*Content ID- A part that defines a unique ID assigned to a Content 113 item....SC Version-A version number assigned to the SC (s)...SC ID--*”, col.33, line 25-col.34, line 50, “..*Transaction ID 535...End-User (s) ID—Verify the Digital Signature 643 of the SC (s)....Verify the integrity and authenticity of each Offer**

SC (s) 641 included in the Transaction Sc (s) 640...”, col.40, line 35-col.41, line 4, “..The ID property is a unique value ...T property specifies the type of the SC (s)...A property identifies the author or publisher....D property identifies the date...E property identifies the date, and optionally, the time that the SC (s) expires...CCURL value...CCURL property identifies the URL of the Clearinghouse (s) 105. The value should be the form of a valid external URL...”, col.44, lines 5-42, “...Validation....The Clearinghouse(s) 105 begins the validation of Order SC 9s) 650 by verifying the digital signatures.....integrity of the Order SC (s) 650 parts...The process of verification of the Transaction and the Offer Sc (S) ....Then, the Storage Usage Conditions 519 of the Content 113...are validated by the Clearinghouse (s) 105.....”, col.45, lines 15-28, “...In all the processing of the Order SC (s) 650 is successful...If the Clearinghouse (s) 105 is not able to successfully process the order SC (s) 650.....The HTML page indicates the reason that the Clearinghouse (s) 105 was unable to process the transaction “, col.46, lines 5-61, col.50, line 34-col.51, line 39, col.54, lines 55-64, col.59, line 7-col.60, line 13, col.72, lines 11-59, col.75, line 1-col.77, line 23, col.79, line 10-col.89, line 20.). Downs further teaches determining if an order identifier is also active-corresponding order must not have been canceled before downloading the ordered file, and non-suppressed -order must not have been canceled after downloading the ordered file, (see Downs at least col.10, line 50-col.11, line 27, wherein Downs teaches that the Clearinghouse (s) 105 checks all transactions relating to sale before authorizing license and later checks if the user is permitted to use the authorized license and this corresponds to checking if the order is canceled before and after the order. Also see at

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least col.6, line 65-col.8, line 5, col.10, lines 19-48, col.81, line 10-col.82, line 22, col.85, lines 53-63.).

Downs does not teach permitting download of the file to the end user machine based on a number of attempted downloads of the file by the user and a number of successful downloads of the file by the user. However, in the analogous field of endeavor, that is method and apparatus of bill payment via a network to prevent fraudulent transactions, Rogers discloses permitting download of the file based on a number of attempted downloads of the file by the user and a number of successful downloads of the file by the user (see at least col. 6, line 33-col. 9, line 17, wherein Rogers teaches that while users conducting bill payments via a network (telephone), the users are allowed certain number of attempts to validate the entry of access codes, account numbers, debit card numbers, dollar amount and if the attempted downloads of the file, that is entering the numbers of access codes, account numbers, debit card numbers, and dollar amount exceed certain numbers a corresponding action is initiated. If the attempts to download the file including the various information relating to numbers, as cited above, are within three attempts the user is allowed to continue the download of the files including that information but if the attempted downloads exceed 3 the transaction is stopped for further validation. Rogers teachings of permitting downloading of files containing access codes, account numbers, debit card numbers, dollar amount based upon the number of attempted downloads, that is three and if the third is successful then the transaction is continued and if unsuccessful then the transaction is discontinued is reasonably pertinent to the particular problem with which

the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In view of Rogers, it would have been obvious to one of an ordinary skill in the art at the time of the invention to have modified Downs to incorporate the feature of permitting download of the file based on a number of attempted downloads of the file by the user and a number of successful downloads of the file by the user. Doing so helps the Downs system to prevent fraudulent use of debit cards for payments, as explicitly suggested Rogers.

3.2. With regards to claims 14-15, the steps of requesting identification of a file name for storing the file, displaying a default identification as the file name for storing the file based upon an identification of the file and transmitting the generated file identifier for display to the user are inherent during the download.

3.3. With regards to apparatus claims 23, 25, 30, 36-38, and 68, their limitations correspond to method claims 1, 3, 8, 14-16, 67 and are, therefore, analyzed and rejected similarly.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 6,597,891 to Tantawy et al. discloses a method for downloading a digital content for playing and recording the content on a receiver's computer medium (see at least Abstract).

**5. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

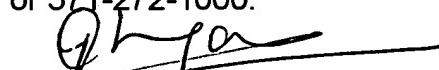
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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Primary Examiner  
Art Unit 3625

YCG  
9/28/06